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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
087949,525	10/14/97	WIENER	ENT970827-1

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LM12/0527

EXAMINER
MEISLAHN, D

ART UNIT	PAPER NUMBER
2767	

DATE MAILED: 05/27/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**08/949,525**

Applicant(s)  
**Michael J. Wiener And Josanne M. Otway**

Examiner  
**Douglas Meislahn**

Group Art Unit  
**2767**



☒ Responsive to communication(s) filed on Apr 2, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-26 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-26 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on Apr 2, 1999 is ☒ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the amendment received on 26 March 1999 which amended the drawings, specification, and claims 1-4, 9-12, 14-18, and 21-24.

### ***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the residence of each inventor. In the phone conversation held 22 March 1999, the examiner mistakenly waived this objection. After conferring with the supervisor of the art unit, the examiner has reinstated this objection. On 23 March 1999, the examiner told Applicant of this.

Neither this objection nor the objection to the wording "... one of the original and first joint ..." can be waived. A supplemental declaration must be supplied upon notice of allowable material.

### ***Drawings***

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3. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 2 April 1999 have been approved.

***Response to Arguments***

4. The amendments have made the claims statutory.

5. The examiner thanks Applicant for shedding light upon the multi-client manager unit. The amendments of the storing section of claim 1 and similar claims have made them clear. The amendments to claims 2, 3, 10, 17 and the claims that are similar have overcome the 112 rejections. The explanation of claim 4 and the amendments of claim 4 and the claims that are similar to it have overcome the 112 rejections. With regard to claim 8, the examiner now understands what the claim is trying to say. The examiner was confused by the idea of putting data in an entry. In the examiner's grammatical experience, data is generally stored in a directory as an entry or stored as a directory entry.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The first step listed in claims 1, 9, 14, and 21 is vague and indefinite. Applicant had suggested reading the claims in view of the specification. However, the examiner does not wish to constrict his view of the invention by solely using the exemplary embodiment. This leaves only line 26 of page 3 through line 2 of page 4 for the examiner to rely upon. The examiner is unsure what "... that is selectable on a per client basis ..." modifies. Also, the examiner is not clear on whether the selectable expiry data includes selectable private key expiry data. In the phone conversation of 22 March 1999, Applicant and the examiner had discussed using commas to remedy these ambiguities.

Claims 2-8, 10-13, 15-20, and 22-26 depend respectively from claims 1, 9, 14, and 21 and therefore inherit their deficiencies.

Claim 26 recites the limitations "storage medium and stored program" in the first line. There is insufficient antecedent basis for this limitation in the claim. It is possible that this error arises from claim 26 depending from 19 instead of 21.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 3, 6, 7, 9, 10, 14, 16, 17, 20, 21, 23, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Dolphin (5457746).

Figure 9 clearly shows an interface that allows selection of key start and expiration dates. <sup>clearly,</sup>  
~~Obviously,~~ this information must be stored somewhere so that it can be put to use. Also, the key attributes are associated with actual keys.

Dolphin's system is designed to be used in conjunction with pay-per-use media, which means that it would have the ability to exclude key updates on a per client basis.

Elements 81 and 82 of figure 13 demonstrate the idea of requesting from and receiving a key that is generated by a multi-client manager unit.

Element 97 of figure 15 mentions key wrapping, which uses public-key cryptography to deliver symmetric keys. This anticipates claim ten.

As can be seen by comparing Applicant's first and ninth claims, key updates are not exclusive to public key crypto systems. Dolphin does not explicitly apply her invention to public key crypto systems, but it is anticipated.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2, 4, 8, 11-13, 15, 18, 22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dolphin (5457746) in view of Perlman (5901227).

Dolphin teaches the selection of key validity periods on a per client basis. She also mentions a system which uses both public and symmetric keys, key wrapping. She does not say anything about digital certificates. Official notice is taken that digital certificates and their uses with keys are old and well-known. One element often associated with digital certificates is a certification authority which receives keys after they have been generated, attaches a certificate of authenticity to the key, and gives it to a user. This is exemplified in lines 39-52 of column 4 of Perlman. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to associate digital certificates with time-limited keys. The certificates would authenticate keys and state the keys' duration. Certificates are flexible in that they are separable from the actual key. By generating the keys at the user sight, security leaks would be reduced.

12. Claims 5, 19, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dolphin (5457746) in view of Applicant's admitted prior art.

Dolphin teaches the selection of key validity periods on a per client basis. She does not specify a time frame in which a client would request key updates. In lines 14 through 19 of page 2, Applicant discusses a conventional public key system in which keys have a fixed default period

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that is "... generally a fixed percentage or a total key lifetime . . . ." Official notice is taken that fixed length renewal periods are old and well-known. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to set key update periods that are based on both a fixed number of days and a percentage of a key's lifetime. This method provides flexibility by giving clients who have keys that have either extremely long or extremely short lifetimes two options as to when to update their key. For example, if a client had a ten-day key, and the renewal time percentage was ten, the client would only have one day to renew the key and could easily miss this window as a result of a weekend. However, if the key was renewable either during the final ten percent of the key's lifetime or during the final three days of the key's lifetime, the exemplary client would not risk missing an update because of a weekend.

### *Conclusion*

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

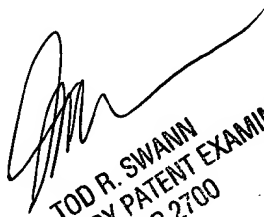
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas Meislahn whose telephone number is (703) 305-1338. The examiner can normally be reached Monday-Thursday and every other Friday from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tod Swann, can be reached at (703) 308-7791.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 305-0040.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

DJM  
May 21, 1999



TOD R. SWANN  
SUPERVISORY PATENT EXAMINER  
GROUP 2700